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Docket No. GJN-01

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s) : Gregory James Newell et al.  
Serial No. : 10/799,137  
Filing Date : March 12, 2004  
Art Unit : 3651  
Examiner : Leslie A. Nicholson III  
For : ROTATABLE FEED WHEEL FOR SHEET CONVERTING MACHINE

Mail Stop Non-Fee Amendment  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

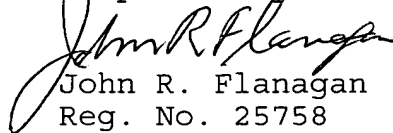
SIR:

TRANSMITTAL LETTER

Transmitted herewith for filing in the PTO in the above-identified patent application is a RESPONSE TO ELECTION/RESTRICTION REQUIREMENT. The total number of claims previously paid for was thirty (30); the total number remaining is thirty (30). The previous number of independent claims paid for was five (5); the number remaining is five (5). No excess claims have been introduced by this RESPONSE; thus, no fee is due as a result of the filing of this RESPONSE.

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Respectfully submitted,

  
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Date: Sept 15, 2005

Certificate of Mailing under 37 C.F.R. 1.8

I hereby certify that this TRANSMITTAL LETTER and accompanying RESPONSE are being deposited with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop Non-Fee Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on 09/15/05.

By: John R. Flanagan  
Reg. No. 25758

 09/15/05  
Signature Date



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RESPONSE TO ELECTION/RESTRICTION REQUIREMENT

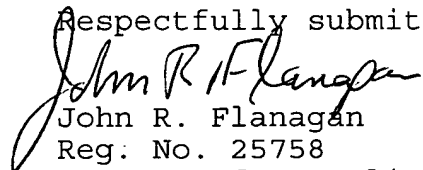
This is in response to an Office Action mailed from the U.S. Patent & Trademark Office (PTO) on August 19, 2005. This Office Action imposed an Election/Restriction Requirement between: (I) rotatable feed wheel combination Claims 1-19; (II) tread subcombination Claims 20-26; and (III) hub subcombination Claims 27-30. Applicants hereby elect rotatable feed wheel combination Claims 1-19 of (I) for prosecution in this application. This election is being made WITH TRAVERSE based on the following arguments and remarks.

It is respectfully submitted that these combination and subcombination claims constitute a single unitary invention in view that, contrary to the Examiner statements, there is no known utility attached to the tread and hub subcombinations separate and apart from their utility as parts of the rotatable feed wheel combination. Separate claim coverage is sought over these non-elected subcombinations to prevent someone from manufacturing and selling only one of the non-elected subcombinations and not the elected combination in an attempt to avoid direct infringement and require Applicants to prove a possibly more difficult case of contributory infringement. The Examiner's citation of examples of separate utilities for these non-elected subcombinations is nothing more than pure speculation. Furthermore, a thorough prior art search of elected combination claims would necessarily include the

same areas as a prior art search of each of the non-elected subcombination claims since the details of tread and hub set forth in the non-elected claims substantially overlap with the details of those parts as set forth in the elected combination claims. The undersigned attorney is highly skeptical that a credible prior art search of the elected combination claims can be performed when limited to only class 271, wherein it is asserted that pertinent prior art to the rotatable feed wheel is found, and not extended to include class 492, wherein it is asserted that pertinent prior art to the tread and hub respectively are found. In view that, at a minimum, considerable overlap would exist between the fields of search for these combination and subcombination claims, the examination of all these claims in the present application is not seen to present an additional burden to the Examiner as it surely will to the Applicant in having to bear the additional unwarranted expense associated with prosecution, issuance and maintenance of potentially three patents instead of one.

Based on the foregoing arguments and remarks, Applicants respectfully submit that the Election/Restriction Requirement imposed by the Examiner is not warranted and respectfully request that it be withdrawn and all claims be examined in the subject application.

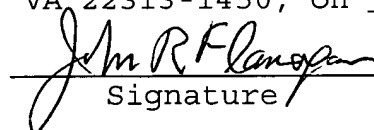
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